

ESTTA Tracking number: **ESTTA518555**

Filing date: **01/29/2013**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

## Petition for Cancellation

Notice is hereby given that the following party requests to cancel indicated registration.

### Petitioner Information

Name	"Traxx Companies"		
Entity	Corporation	Citizenship	Kentucky
Address	250 West Main Street Suite 3030 Lexington, KY 40507 UNITED STATES		

Attorney information	Michael S. Hargis King & Schickli, PLLC 247 North Broadway Lexington, KY 40507-1058 UNITED STATES michael@iplaw1.net Phone:8592520889
----------------------	--

### Registration Subject to Cancellation

Registration No	4027532	Registration date	09/20/2011
Registrant	Trax International Corporation 8337 W Sunset Rd, Bldg 2, Ste 250 Las Vegas, NV 89113 UNITED STATES		

### Goods/Services Subject to Cancellation

Class 037. First Use: 2004/06/01 First Use In Commerce: 2004/06/01 Cancelled goods and services in the class: Construction supervision services, namely, providing construction project management; Road construction, namely, installation and maintenance of roads; Installation and maintenance of HVAC systems, telephone systems, digital communications networks, Closed Circuit Television surveillance, and remote access control devices; Installation and maintenance of military equipment and defense systems, namely, weapons and testing equipment; Maintenance and upgrading of computer hardware and peripheral computer equipment; Installation of computer hardware; Vehicle maintenance; Providing custodial services in the nature of janitorial services; Installation of military testing and defense systems; Maintenance of military testing and defense systems; Modification services, namely, modification of military testing and defense systems
--

### Grounds for Cancellation

Other	Portions of the identification are overly broad and Petitioner seeks partial cancellation under Trademark Act section 18.
-------	---

Related Proceedings	Petitioner is filing a separate Request for Partial Cancellation, concurrently herewith, for Registrant's Registration No. 3,906,111 for the mark TRAX INTERNATIONAL on the same grounds and facts, and requesting the same relief
---------------------	--

Attachments	Petition To Cancel -532.pdf ( 11 pages )(3048783 bytes )
-------------	--

### **Certificate of Service**

The undersigned hereby certifies that a copy of this paper has been served upon all parties, at their address record by First Class Mail on this date.

Signature	/Michael S. Hargis/
Name	Michael S. Hargis
Date	01/29/2013

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

In the Matter of Registration No. 4,027,532  
For the mark TRAX  
Registered on September 20, 2011

<b>"TRAXX COMPANIES",</b>	:	
	:	
Petitioner,	:	
v.	:	<b>CANCELLATION NO. _____</b>
	:	
<b>Trax International Corporation,</b>	:	
	:	
Registrant.	:	

**PETITION FOR PARTIAL CANCELLATION**

"Traxx Companies" ("Petitioner"), a corporation of the Commonwealth of Kentucky, having a place of business at 250 West Main Street, Suite 3030, Lexington, Kentucky 40507, believes that it is and will continue to be damaged by U.S. Registration No. 4,027,532 ("the '532 Registration"). Petitioner hereby petitions for partial cancellation of the services recited in the '532 registration, namely, "vehicle maintenance," pursuant to 15 U.S.C. §§1067-68.

As grounds for its request for partial cancellation, Petitioner alleges that:

1. On information and belief, Trax International Corporation ("Registrant") is a New Mexico corporation having a place of business at 8337 West Sunset Road, Building 2, Suite 250, Las Vegas, Nevada 89113.
2. Registrant is the identified owner of the '532 Registration, registered on September 20, 2011, for the standard character mark TRAX for use in association with the following

services:

(Class 035) business management services, namely, management of military equipment and materials; business advisory and consultancy services in relation to military testing and defense systems, namely, management of military testing and defense systems; telecommunications network management services, namely, the operation and administration of telecommunication systems and networks for others; business services, namely, management of computer and communications systems for commercial, industrial, and military operations industries; management of industrial and military operations, namely, providing operational oversight and business maintenance for industrial and military operations; business consulting services in the field of internal process optimization and on the job process hazards analysis; business acquisition and merger consultation; corporate governance consulting services, namely, economic, strategic planning, budgeting, contingency planning, social risk assessment and developing sustainable work systems; management of secure business information distributed on global computer information networks and on local computer networks; management of telephone call centers for others; inventory management; transportation logistics services, namely, transportation planning and scheduling shipments for users of transportation services; preparing oral presentations and business reports in the nature of briefs for others in the field of engineering, software development, logistics support, multimedia and facilities maintenance and operations; construction office administration services, namely, providing

cost and schedule control, document control, utility coordination, contract administration, contractor coordination and change order control; duplication of documents;

(Class 037) construction supervision services, namely, providing construction project management; road construction, namely, installation and maintenance of roads; installation and maintenance of HVAC systems, telephone systems, digital communications networks, closed circuit television surveillance, and remote access control devices; installation and maintenance of military equipment and defense systems, namely, weapons and testing equipment; maintenance and upgrading of computer hardware and peripheral computer equipment; installation of computer hardware; vehicle maintenance; providing custodial services in the nature of janitorial services; installation of military testing and defense systems; maintenance of military testing and defense systems; modification services, namely, modification of military testing and defense systems;

(Class 038) dispatch telecommunication services, namely, electronic transmission of voice and data messages for the purpose of logistics management of government facilities and installations;

(Class 039) logistics services and support for U.S. general services administration, U.S. Department of Defense, National Aeronautics and Space Administration, and other governmental entities, namely, warehousing, distribution and transportation of office supplies, military, space flight and commercial hardware, equipment, inventory and military, space flight and commercial goods, and safekeeping of

such items while in storage; packaging of articles for transportation in connection with the operation and management of government facilities and installations; freight traffic management in the nature of traffic control in connection with the operation and management of government facilities and installations; archiving services in the nature of providing electronic storage of data for others;

(Class 040) environmental remediation services, namely, decontamination of hazardous materials, namely, unexploded ordinance and materials cleanup; environmental remediation services, namely, soil, waste and/or water treatment services; waste management; environmental pollution control services, namely, air, water, groundwater, waste water, and soil treatment; duplication of audio/visual tapes and recordings;

(Class 041) training in the use and operation of scientific and computer instruments and services for instructors, operators, engineers, and technicians in the fields of power, water and food supply, and security systems; training in the fields of environmental management and pollution control, waste management and remediation engineering, process engineering and design and corporate reporting; training in the field of aircraft flight; photography, digital imaging; documentary and informational video production; training in the field of hazardous material cleanup and remediation;

(Class 042) engineering and architectural analysis, namely, creating plans, specification and designs for others; designing and engineering computer systems, HVAC systems, telephone systems, digital network systems, closed circuit

television surveillance systems, power generation systems, pollution control system and equipment, desalination processes, military testing systems, and infrastructure systems; technical assistance in the field of engineering and architecture; land-use planning services; computer security consultation services; computer security service, namely, restricting access to and by computer networks to and of undesired web sites, media and individuals and facilities; design and development of computer networks; software development for a wide spectrum of engineering and business applications for use by government and commercial entities, namely, complex database driven engineering design tools, process simulation tools, data input systems, web-based operations and tools, and industry standard interfaces to all types of computer hardware, computer control systems, and computer application programs; technological advisory and consultation services in the technology field of computer hardware systems and military testing systems; maintenance and upgrading of computer software; information technology services in the field of computer system integration; website design for others; environmental assessments in the nature of testing and inspection services; computer services, namely, design, development, installation and implementation of new computer software programs and computer hardware all for use in military testing and defense systems; information technology services, namely, integration of computer and communications systems for commercial, industrial, and military operations; installation and maintenance of computer software for use in weapons and equipment testing; development of software programs for operator training

simulators and development of operating procedures for power generation plants; electronic scanning of photographs; providing analysis of data and test results from military testing and defense systems for the improvement of such defense systems; and

(Class 045) guard services; providing physical personal security guard services and guard services for facilities; reviewing standards and practices to assure compliance with environmental zoning laws and regulations; providing regulatory compliance services for industrial and military operations.

3. Petitioner filed an application for registration (Ser. No. 85/480,975) of the mark TRAXX (“‘975 Application”) for use in association with retail store services featuring convenience store items and gasoline in Class 035 and vehicle cleaning and washing services in Class 037.

4. On March 12, 2012, a first Office action issued in Petitioner’s ‘975 Application wherein the Examining Attorney initially refused registration under Section 2(d) of the Trademark Act based on the ‘532 Registration. Specifically, the Examining Attorney stated that “[a]pplicant’s services ‘retail store services featuring convenience store items and gasoline; vehicle cleaning and washing services’ are closely related to registrant’s services, ‘vehicle maintenance.’”

5. The Examining Attorney further stated in the first Office action that “the presumption under Trademark Act Section 7(b), 15 U.S.C. §1057(b), is that the registrant . . . operates in all normal channels of trade and reaches all classes of purchasers of the identified goods and/or services . . . . *see* TMEP §1207.01(a)(iii).”



6. The Examining Attorney further stated in the first Office action that “there are no limits on the channels of trade in the application, so it is presumed that applicant’s services will all travel in all normal channels of trade and reach all classes of purchasers of the identified services. Thus, the trade channels will not distinguish the services.”

7. The Examining Attorney then concluded in the first Office action that “confusion as to source is likely and registration of the mark in relation to the services is refused under Trademark Act Section 2(d) based on a likelihood of confusion.”

8. In response to the initial refusal of registration under Section 2(d), Petitioner argued *inter alia* in its response filed on July 9, 2012, that Registrant’s services were generally directed to the United States government and its agencies and entities (e.g., the Department of Defense, General Services Administration, and National Aeronautics and Space Administration), and specifically, that Registrant’s vehicle maintenance services were directed to Department of Defense and foreign military vehicles including both wheeled and tracked combat support vehicles, agricultural equipment, and amphibious vehicles.

9. In support of these statements made in its response of July 9, 2012, Petitioner submitted Exhibit H that included a print-out of Registrant’s webpage which read in pertinent part “[Registrant] provides qualified personnel to operate and maintain DoD and foreign military vehicles.”

10. On July 30, 2012, the Examining Attorney issued a final Office action noting that “[a]bsent restrictions in a registration, the identified services are presumed to travel in the same channels of trade to the same class of purchasers . . . unrestricted and broad identifications are presumed to encompass all services of the type described.” The Examining Attorney concluded

by stating that “[i]n this case, the identification set forth in the registrations has no restrictions as to nature, type, channels of trade, or classes of purchasers. Therefore, it is presumed that these services travel in all normal channels of trade, and are available to the same class of purchasers.”

11. In response to the final Office action and refusal of registration under Section 2(d), Petitioner filed a Request for Reconsideration on September 20, 2012, that amended the ‘975 Application identification of services by deleting the Class 037 services entirely, and restricting the Class 040 services to read “retail store services featuring convenience store items and gasoline, excluding vehicle maintenance services.”

12. On October 19, 2012, The Examining Attorney denied the Request for Reconsideration stating that “[a]pplicant has narrowed the identification of services. However, the remaining services are closely related to the registered services . . . [a]ccordingly, the request is denied.”

13. At the time of filing this Petition for Partial Cancellation (“Petition”), Petitioner’s ‘975 Application is finally refused under Section 2(d) of the Trademark Act based on a likelihood of confusion with the mark in Registrant’s ‘532 Registration.

14. On information and belief, Registrant provides government services and energy solutions, and its areas of expertise include Department of Defense (DoD) program management, energy solutions, and other Federal contracting.

15. On information and belief, Registrant’s energy solutions are primarily based on the delivery of customized energy solutions using power plant modeling and simulation software, and are not related to vehicle maintenance.

16. On information and belief, each of Registrant’s services are provided under contract.

17. On information and belief, Registrant's vehicle maintenance services are provided under contract.

18. On information and belief, Registrant does not provide any services to the general public.

19. On information and belief, Registrant does not provide vehicle maintenance services to the general public.

20. On information and belief, Registrant does not provide vehicle maintenance services in a retail setting.

21. On information and belief, Registrant provides vehicle maintenance services directed only to Department of Defense and foreign military vehicles.

22. On information and belief, Registrant does not provide retail store services.

23. On information and belief, Registrant does not provide retail store services featuring convenience store items and gasoline.

24. On information and belief, the "vehicle maintenance" services identified in the '532 Registration are overly broad in light of the actual services provided by Registrant.

25. During examination of the '975 Application, the Examining Attorney has construed the "vehicle maintenance" services to broadly encompass all normal channels of trade and reach all classes of purchasers of the services.

26. As a result of the Examining Attorney's broad construction of Registrant's vehicle maintenance services set out in the '532 Registration, Petitioner is presently barred from securing a federal registration for its mark under Section 2(d) of the Trademark Act based on a likelihood of confusion.

27. Restriction or limitation of Registrant's identification of services, and specifically vehicle maintenance services in Class 037, to read either:

- (1) vehicle maintenance, namely, military vehicle maintenance;
- (2) vehicle maintenance, namely, military vehicle maintenance provided under contract;
- (3) vehicle maintenance, namely, military vehicle maintenance provided under contract and not to the general public;
- (4) vehicle maintenance, namely, military vehicle maintenance provided under contract and not to the general public or in a retail setting; or
- (5) vehicle maintenance, namely, vehicle maintenance on of U.S. Department of Defense and foreign military vehicles,

will eliminate even a likelihood of confusion with Petitioner's mark.

28. Each of the restrictions or limitations on Registrant's vehicle maintenance services proposed in paragraph 27 properly restrict or limit Registrant's services to those actually provided in U.S. commerce and are sufficiently restricted to eliminate a likelihood of confusion with Petitioner's mark in its '975 Application. The proposed restrictions (1) - (5) in paragraph 27 are plead in the alternative such that if the Board determines that (1) is insufficient to avoid a likelihood of confusion, then (2) should be, and so on.

29. If this Petition is granted and the services in the '532 Registration restricted or limited as requested, then the refusal of registration under Section 2(d) of the Trademark Act based on a likelihood of confusion with the mark in Registrant's '532 Registration would be withdrawn.

**WHEREFORE**, Petitioner believes that it is and will continue to be damaged by


Registration No. 4,027,532, and requests that the Petition for Partial Cancellation be sustained and that judgment be entered against Registrant. Said judgment partially cancelling the '532 registration in part by restricting or limiting the vehicle maintenance services specified therein in accordance with one of the proposed alternatives set forth in paragraph 27.

The Fee under 37 CFR §2.6(a)(16)(\$300/class x 1) is being paid by Deposit Account at the time of filing with ESTTA. Any deficiency in the fee should be charged to Deposit Account No. 11-0978.

Respectfully submitted,

January 29, 2013

By:

  
\_\_\_\_\_  
Michael S. Hargis  
KING & SCHICKLI, PLLC  
247 North Broadway  
Lexington, KY 40507-1058  
Telephone: (859) 252-0889  
Facsimile: (859) 252-0779  
COUNSEL FOR Petitioner